87-1817

No. -

Supreme Court, U.S.
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In the
Supreme Court of the United States

OCTOBER TERM, 1987

THOMAS FERREIRA, ANDREW BRENNAN AND
F & B ENTERPRISES, INC.,
PETITIONERS,

v.

BRUCE'S SPLICING AND RIGGING CO., INC.,
RESPONDENT.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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Questions Presented.

I. Does 35 U.S.C. § 285, limiting the award of attorney fees in a patent case to only a prevailing party, preempt an award of attorney fees under the Court's inherent equitable power to a nonprevailing party?

II. Does the rule that equity will not aid a wrongdoer preclude an award of attorney fees under the inherent equitable powers of a district court to a nonprevailing patentee whose patents were acquired by inequitable conduct even though the prevailing party was found to have orchestrated testimony of certain witnesses who were conspicuous liars?

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioners, Thomas Ferreira, Andrew Brennan and F & B Enterprises, Inc., respectfully pray that a writ of certiorari issue to review the Order of the United States Court of Appeals for the Federal Circuit entered in cross appeal 87-1172 of this case on February 2, 1988.

Opinions Below

The opinions of the United States District Court of the District of Massachusetts are unreported but have been reproduced in the appendix to this petition at pages 7a-43a. The opinion of the Court of Appeals for the Federal Circuit also is unreported but is reproduced in the appendix to this petition at pages 1a-6a.

Jurisdiction.

The United States District Court had original jurisdiction of this matter pursuant to 28 U.S.C. § 1338(a). The judgment of the Court of Appeals for the Federal Circuit was entered on December 22, 1987. Petitioners' timely petition for rehearing was denied on February 2, 1988 and this petition for certiorari is being filed within 90 days of that date. A copy of the order denying the petition for rehearing is printed in the appendix at page 54a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

Statutes Involved.

35 U.S.C. § 285 states:

> The court in exceptional cases may award reasonable attorney fees to the prevailing party.

Statement of the Case

Respondent (hereafter Bruces) asserted petitioners (hereafter F & B) infringed its patents 4,349,972 issued September 29, 1982 and 4,328,629 issued May 11, 1982 relating to Shellfish Dredge Chafing Gear. F & B's defense alleged *inter alia* that the patents were invalid and unenforceable because of Bruces' inequitable conduct in procuring the patents in suit. After a trial on the merits, the District Court entered a judgment that the patents were unenforceable due to Bruces' inequitable conduct and that Bruces' complaint be dismissed with prejudice (App. 47a-51a). Notwithstanding, the District Court awarded attorney fees to Bruces, the nonprevailing party, in accordance with Memorandum Orders of December 27, 1985 and June 17, 1986 (App. 31a-40a). Proceedings to determine the amount of attorney fees were stayed pending appeal (App. 39a-40a).

The complaint was dismissed because Bruces' failure to disclose material prior art to the Patent Office, amounted to inequitable conduct (App. 7a-30a). Nonetheless, the Court concluded that because at least one defense raised by F & B was not made in good faith, an award of attorney fees to the Bruces was appropriate under general equitable principles (App. 31a-38a). The Court stated:

> Plaintiff cannot claim under Section 285. However, even as a loser it is not barred under general equitable principles. (App. 33a.)

The Court of Appeals for the Federal Circuit affirmed the holding that the patents in suit were unenforceable due to Bruces' inequitable conduct. It also affirmed the award of attorney fees based on general equitable principles to Bruces,

the nonprevailing party, by adopting what it perceived was the law of the First Circuit, rather than the law of the Court of Appeals for the Federal Circuit (App. 5a).

Reasons for Granting the Writ.

Prior to the enactment of 35 U.S.C. § 285 and its predecessor, attorney fees in patent cases were not available under the general equity powers of the courts. *Parks* v. *Booth*, 102 U.S. 96 (1880). This was totally consistent with the American Rule. Attorney fees in a patent case were first provided by Congress in an amendment to Section 4921 of the revised statute. That section was ultimately amended to the present 35 U.S.C. § 285 which only permits an award of attorney fees to a prevailing party. Since Congress carved out specific exceptions to the nonavailability of attorney fees and the present case does not come within those exceptions, the decision below is preempted and represents judicial legislation which thwarts express congressional policy. The facts upon which the District Court has relied in awarding attorney fees fall squarely within the type of conduct upon which courts routinely rely in awarding fees under § 285. "Cases awarding attorney fees [under § 285] have typically found 'exceptional' circumstances . . . in prolongation of litigation and bad faith." *Rohm and Haas* v. *Crystal Chemical Co.*, 736 F.2d 688, 690, 220 U.S.P.Q. 97, 98 (Fed. Cir. 1984), *cert. denied*, 105 S.Ct. 172 (1984). However, Congress has mandated under Section 285 that such facts permit an award only to the prevailing party. An award of attorney fees on any other basis as in the present instance is preempted. Accordingly, this case provides an appropriate vehicle to limit judicial legislation in areas preempted by Congress.

The award of attorney fees to a nonprevailing party whose actions in procuring a patent amounted to inequitable conduct is improper in view of this Court's long established precedent that equity should not aid a wrongdoer. The maxim that equity will not aid a wrongdoer "is a self-imposed ordinance that closes the doors of a court of equity to one tainted with inequitableness or bad faith relative to the matter in which he seeks relief, however improper may have been the behavior of the defendant." *Precision Instrument Manufacturing Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806, 814-815, 65 S.Ct. 993, 89 L.Ed. 1381 (1945). This Court further held in *Precision* "while equity does not demand that its suitors have led blameless lives . . . as to other matters, it does require that they shall have acted fairly and without fraud or deceit as to the controversy in issue." *Id.* at 814-815, 65 S.Ct. at 997, quoting *Loughran* v. *Loughran*, 292 U.S. 216, 229, 54 S.Ct. 684, 78 L.Ed. 1219 (1934). Letting the lower court's decision stand will allow an inroad on a long standing policy of this Court.

Conclusion.

For the foregoing reasons, this Court should grant a Writ of Certiorari to review the judgment of the Court of Appeals for the Federal Circuit in cross appeal 87-1172 below.

Respectfully submitted,

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Appendix A

NOTE: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

United States Court of Appeals

for the Federal Circuit

87-1142, 87-1172

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF-APPELLANT,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS-CROSS-APPELLANTS.

DECIDED: December 22, 1987

Before RICH, SMITH, and NIES, *Circuit Judges*.

SMITH, *Circuit Judge*.

DECISION

The United States District Court for the District of Massachusetts held that claims 2, 8-11, 15, 16, and 18 of patent

No. 4,349,972 ('972 patent) were valid and infringed, but that the '972 patent and patent No. 4,328,629 ('629 patent) were unenforceable due to inequitable conduct on the part of Bruce's Splicing & Rigging Co. (Bruce's) in obtaining the patents. The district court also awarded attorney fees to Bruce's for its defense of certain claims of prior use made by Ferreira, Brennan, and F & B Enterprises, Inc. (collectively referred to as F & B) on the basis of general equitable principles. Bruce's appealed the holding of unenforceability due to inequitable conduct, and F & B appealed the grant of attorney fees to Bruce's. We *affirm*.

OPINION

The patent in this case involves a shellfish dredge chain bag protected with rubber strips. The chain bag, which is used to catch shellfish, is dragged across the bottom of the ocean. This dragging causes wearing, or chafing, of the bags and led to the need for some method to protect the bags. A variety of materials were tried, among them parts of old chain bags and pieces of truck tire. Bruce's invention consisted of using pieces of tire attached at a forward point which trailed under the bag to protect it from chafing.

During the prosecution of the patent applications, Bruce's attorney became aware of the prior public use of tire tread attached horizontally across the bag, the belly-band. This information was not given to the patent examiner during prosecution, and the '629 patent issued on May 11, 1982, with the '972 patent issuing later.

Bruce's filed suit for infringement against F & B, and a trial was held in the district court in Massachusetts. The trial concerned the validity of the claims of the '972 patent, since F & B had stipulated to infringement if the claims were valid.

One of the defenses raised by F & B was inequitable conduct. The district court found the patent valid and infringed, but unenforceable due to the failure of Bruce's attorney to reveal the bellybands to the patent examiner. The court made extensive findings on the testimony of F & B's witnesses, concluding that they were "conspicuous liars." Based on this conduct, the court awarded Bruce's attorneys fees for its defense of certain early uses of the tire pieces. The court considered F & B's argument that Bruce's should not be awarded any attorney fees because of its inequitable conduct in prosecuting the patent, but found that Bruce's conduct did not offset F & B's conduct.

Inequitable Conduct

Inequitable conduct requires proof by clear and convincing evidence of a threshold degree of materiality of the non-disclosed information and proof of a threshold intent. Materiality may be shown by any one of four tests: (1) objective "but for"; (2) subjective "but for"; (3) "but it might have been"; and (4) whether there is a substantial likelihood that a reasonable examiner would have considered the omitted reference important in deciding whether to allow the application to issue as a patent. *J. P. Stevens & Co.* v. *Lex Tex Ltd.*, 747 F.2d 1553, 1559, 223 USPQ 1089, 1092 (Fed. Cir. 1984), *cert. denied*, 474 U.S. 822 (1985). In proving intent, it is not necessary to show proof of deliberate scheming; evidence of gross negligence is enough. 747 F.2d at 1560, 223 USPQ at 1092. Gross negligence is present when the actor, judged as a reasonable man, should have known of the materiality of the reference. *Kansas Jack, Inc.* v. *Kuhn*, 719 F.2d 1144, 1152, 219 USPQ 857, 862 (Fed. Cir. 1983). After the threshold showings of materiality and intent are made, the court must balance them and determine as a matter of law whether inequitable

conduct has occurred. *J. P. Stevens,* 747 F.2d at 1562, 223 USPQ at 1094; *American Hoist & Derrick Co.* v. *Sowa & Sons, Inc.*, 725 F.2d 1350, 1364, 220 USPQ 763, 774 (Fed. Cir.), *cert. denied,* 469 U.S. 821 (1984).

Bruce's argues that the bellybands were not material because they were attached crosswise and along their length, as opposed to the invention which was attached at one point and trailed beneath the bag. It contends that, because the bellybands taught away from the invention, they were not material. This argument ignores the fundamental way in which the bellybands were similar to the invention. They were pieces of tire attached to the bags to protect them from chafing. They were a step along the way in the development of the invention. That there were differences from the invention as claimed does not prevent them from being important to the examiner in deciding whether to allow the claims. The district court was not clearly erroneous in so finding.

Bruce's also claims that the district court erred in finding intent because the court refused to consider the evidence that its attorney acted in good faith. It contends that the actions of its attorney were reasonable and taken with due regard for the duty of candor. According to Bruce's, the failure to disclose the bellybands was at worst an error in judgment and cannot be considered gross negligence. Contrary to Bruce's assertion, the court did consider the testimony of counsel, but found it outweighed by three "special advantages" of not disclosing the bellybands. The court also stated that the disclosure of the use of old chain bags in the background accentuated the problem of the nondisclosure of the bellybands. Bruce's has failed to show that the district court clearly erred in finding Bruce's attorney grossly negligent.

Finally, Bruce's argues that the court did not balance the findings of materiality and intent and that, if it had, it would have found no inequitable conduct. Bruce's having failed to

show that the court's findings of materiality and intent were clearly erroneous, and having failed to show that its conclusion of inequitable conduct was in error, the judgment must be affirmed in this respect.

Attorney Fees

F & B contends that the district court erred as a matter of law in granting attorney fees to Bruce's. According to F & B, a losing party may never be awarded attorney fees. Even assuming some losing parties could be awarded fees, F & B argues that a party guilty of inequitable conduct cannot obtain such an award.

The attorney fees awarded in this case were not granted under 35 U.S.C. § 285 (1982) because Bruce's was not the prevailing party. Instead, the court awarded the fees based on general equitable principles. In doing so, the court considered the conduct of F & B's witnesses at trial and of its attorneys during the litigation. The court was "satisfied beyond a reasonable doubt that the defense on this issue [of prior use] was not made in good faith." The court also identified some of F & B's witnesses as "conspicuous liars."

In support of its award, the district court cited *McEnteggart* v. *Cataldo*, 451 F.2d 1109 (1st Cir. 1971), *cert. denied*, 408 U.S. 943 (1972). F & B contended that the law of this circuit should be applied to the award of fees, and that the First Circuit case is not binding precedent. Contrary to F & B's contention, the award of attorney fees under general equitable principles is a matter not unique to patent law; consequently, the law of the First Circuit is the applicable law. *Cf. Panduit Corp.* v. *All States Plastic Mfg. Co.*, 744 F.2d 1564, 223 USPQ 465 (Fed. Cir. 1984). F & B has shown neither legal error nor abuse of discretion by the district court in its grant of attorney fees to Bruce's.

Conclusion

The district court did not err in holding the '972 patent and the '629 patent unenforceable due to inequitable conduct on the part of Bruce's during the prosecution of the applications for the patents. There was also no error in the court's award of attorney fees to Bruce's based on general equitable principles. We affirm the judgment of the United States District Court for the District of Massachusetts.

Appendix B

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

CIVIL ACTION
No. 82-2220-A

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS.

OPINION

November 13, 1985*

This case, which principally involves the question whether the assignee of U.S. Patent No. 4,349,972, for Shellfish Dredge Chafing Gear, dated September 21, 1982, plaintiff Bruce's Splicing & Rigging Co., Inc., a corporation owned by Walter J. and Wayne M. Bruce, father and son, the inventors, can obtain an injunction against, and recover damages from, defendants Ferreira, Brennan and F & B Enterpises, Inc., because of their manufacture and sale of so-called shingles, rubber chafing gear, made of strips from discarded tires, used to reduce the wear on the bottom of chain bags dragging

*The opinion of August 29, 1985, is withdrawn as a result of reargument on plaintiff's motion to reconsider the findings therein of inequitable conduct.

for shellfish, notably scallops. The length of this sentence is deliberate. The trial, promised to be no more than five days, lasted thirteen, although there is no real issue as to invention or infringement. Plaintiff is burdened with a claim of late filing and a need for extensive explanation of its Patent & Trademark Office (PTO) behavior, and defendants are burdened, inter alia, with a number of witnesses who were, in the court's opinion, not to put too fine a point on it, conspicuous liars. Each side exhibits some of the personal condemnation of the other that seems customary in patent cases. The court, in spite of all that has taken place, approaches writing this opinion with an exceptionally open mind, other than initial views, pro and con, about witnesses, and indeed, with much interest as to how it will come out.[1]

Starting with the invention itself, in earlier days scallop fishing was largely confined to soft bottom, which was easier on the gear, but eventually many found it desirable to move to hard, viz., rocky, bottom. This meant picking up rocks in the bag, and much greater wear, or chafing, even apart from this. About that time there was a great increase in the cost of the bags, which were made of steel links. Various means were attempted to reduce the chafing. The first was to use remnants of the old bags. This was cheap, but not too successful. Many fishermen turned to rubber, in various forms. The most popular, adopted around 1974, was known as the bellyband, conceived by the Bruces. This was made by cutting a tire once, cutting away the sidewalls, punching holes about every 12 inches in the tread, and spreading it cross-wise beneath and across the bottom of the bag, fastening to the links by chain and

[1] As counsel was advised, this has been a piecemeal opinion, written (and rewritten) during an extended summer recess. At this point I had read once, though not carefully, the four post-trial briefs. Since then I have studied the briefs in depth, read most of the transcript verbatim, examined a number of exhibits, and read law. While the content has been revised, I have kept the original sequence.

shackles. As a tire stretches out to 9 or 10 feet, and the bags commonly run 13, short pieces were sometimes used to fill out. Bellybands were thought by many hard-bottom fishermen to be much better than old chain bags; by some not. The band, naturally, had thickness, and the protruding leading edge "dug in." Some thought this reduced fishing efficiency. In any event, the exposed attaching chains and shackles wore fast, and were expensive; nor could bellybands cover the whole bag.[2]

Occasionally some fishermen attached a number of short pieces lengthwise, in the direction of the travel, known as ups and downs. There was still heavy wear, due to the protruding leading edge, and exposure of the fastenings, which would wear off or the rubber would pull off, and their use was not general.

Other devices were tried, including rubber discs and rollers, until, at a date as to which there was a dispute, there developed the so-called banana skin, the subject of plaintiff's first patent. A banana skin is a narrow slice, cut normally from the sidewall of the tire, retaining its curve, and thus resembling a banana. One end can be inserted into the bag, due to the relative size of the link, and fastened by various methods, the remainder trailing underneath, outside.[2,5] Banana skins had to be attached in large numbers, 100 or so, to make an effective coat.

Banana skins were sometimes made double, joined at the top. These tore off and were not successful.

The Bruces filed an application for the device, single and double, on October 28, 1980, that became Patent No.

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[2]At trial prosecuting counsel testified that he had not been told that more than one crossband was ever used at a time. His notes, however, show that in June, 1981, Walter Bruce told him that more than one line was sometimes used, and this is confirmed by counsel's sketching. I am quite willing to believe that counsel merely forgot; nor do I regard this forgetting to be a matter of importance.

[2,5]This description is an over-simplification. See post.

4,328,629 on May 11, 1982. General use having admittedly occurred in November, 1979, and counsel having been retained the month following, no explanation has been offered why the filing was that late. I will not speculate, except to say it proved most unfortunate. Although the Bruces were working on improvements, no benefits resulted here from the delay, but an enormous amount of unnecessary trouble for plaintiff, and, at the least, much trial time for everyone, due to defendant's conceived claim of late filing.

The first trouble was that defendants began infringing, as shown by an advertisement in National Fisherman for September, 1980. This resulted in the Bruces filing a petition under Rule 102 to make special.[3] The PTO, in response, invited a showing of the date of first use. The Bruces answered with affidavits, and, later, after a rejection for their insufficiency, a second set of affidavits, of themselves and two others, Donald Calnan and Edward Perry, to show that use made more than a year before filing had been only experimental. A response was also filed by Attorney John N. Williams, of the firm of Fish & Richardson, the firm that now, and at all times, has represented the Bruces and the plaintiff. As a result of the second set of submissions, the PTO was satisfied, and the patent issued.

One of defendants' principal claims is that there were serious errors in these submissions, and that this patent, and the subsequent one for shingles, likewise, should be voided for inequitable conduct. The court, early in the trial, inquired whether Mr. Williams' testimony was intended, and, sua sponte, raised the question whether any exception section of the Disciplinary Rules of the Code of Professional Responsibility allowing him to testify might be applicable. Plaintiff asked

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[3] Interestingly enough, the two claims that were identified as "unquestionably infringed" were, in one instance, disallowed, and in the other, later disclaimed.

that this matter be determined. The court eventually concluded, not without considerable reluctance, that Mr. Williams could testify, under certain conditions. No objections were made at any time by defendants, although the court urged them not to be reluctant, and, accordingly, the record need not be reviewed. I do remark at this time that although the unpleasant word malpractice may not have been used, it was present in my mind, and I felt, I hope not over-simplistically, that perhaps the fairest thing was that everything should come out at once, and that counsel have such an opportunity, if he wished it, or felt he should be heard. One matter seemed very clear, plaintiff could not afford to pay new trial counsel, and the case was unattractive contingently-wise, so that the only alternative was that Mr. Williams' testimony be forbidden.[4]

The banana skins were thought by many to be an improvement over old chain bags and crosswise bellybands (hereinafter crosswise bands), but they wore off, and the need for a large number, that had to be individually fastened, meant much work, especially when replacing at sea, and crews complained. Also, attachment required some skill, and hence, possibly, supervision. A further fault was that if the skin wore off, the shackle and rings remained, and were in the way. However, the net improvement over all previous devices led to a substantial, though by no means complete, adoption for hard bottom fishing. The Bruces continued to experiment, and in about June, 1980, conceived the idea of the shingle. This is much wider than the banana skins actually manufactured, is preferably about 14 inches long and was made out of the tread of the tire. A hole is punched near one end, and the shingle, unless installed when the chain bag is built, is split down the

[4]I took considerable external advice from qualified individuals as to whether the exceptions to receiving counsel's testimony be more liberally, or less liberally, construed at a bench trial, but with a wide, and hence inconclusive, response.

middle, from the hole to the other end. It thus could be rather readily draped over a link from the inside of the bag, the natural tire curve making the rest conform on the outside. Hence, in addition to no protruding leading edge, no attachment device was needed, and the butt, which served as such, was unexposed and did not wear. This, when the design was perfected, solved all problems, and the court unhesitatingly concludes that it was not obvious. Its improvements, after some five years of troublesome bellybands, is attested to by the vigor with which this suit is pursued. This is not to say that no patent claims were overbroad, a subject that will be considered later.

The petition to make the banana skin application special was filed on March 10, 1981, and on April 24 the Bruces filed the shingle application. This was stated to be a continuation in part of the banana skin application, still pending. A petition to make this special was filed on August 21, 1981, accompanied by more affidavits with respect to uses prior to October 28, 1979.

Shortly before the '972 patent issued, plaintiff brought this suit on the '629 patent, and later added the second. After considerable discovery, on August 14, 1984 it disclaimed several claims in both patents, and at the outset of the trial, December 18, 1984, it sought to dismiss all counts as to the '629 patent. Defendants objected, saying that they wished to pursue their counterclaim of invalidity of its remaining claims. The court has not ruled on this motion.

One further matter, on September 20, 1984, plaintiff filed a reissue application as to the '972 patent. Defendants claim inequitable conduct in connection therewith.

Basic issues in this case raise substantial questions of credibility. In considering them, I attach importance not only to the appearance, manner, and testimony of the individual witnesses, but apply the fundamental touchstone of reasonable-

ness; what is reasonable to believe? Particularly with respect to this last, this case was, much more than many, an overall stage play. There was a stage in the very real sense; the question is, was it "staged" in the bad sense.

The Bruces, and, in this instance, patent counsel, Mr. Williams, hereinafter sometimes counsel, are obviously highly interested. Defendants make the claim that many of their witnesses were not. I do not agree; indeed, I ended with just the opposite impression. New Bedford is a city, but, I suspect, in its fishing aspect it is a small town, in interests, cliques, and rivalries. When opposing plaintiff's motion to dismiss and urging that the case of the '629 patent should be kept open, defendants' counsel asserted that if plaintiff won with respect to the '972 patent, the prices of shingles would "skyrocket." In this circumstance it is plaintiff against the world. Even some of the witnesses who were not fishermen were friends of fishermen, or of defendants, and it is not inconceivable that they would get together. In fact, it was not inconceivable at all. Both his counsel and defendant Ferreira himself told me that Ferreira drove several witnesses back and forth from New Beford. Further, these witnesses, due to the court's acceptance of defendants' request that witnesses be excluded from the courtroom, sat together for hours in the hallway; some, indeed, for days. Ferreira, himself, was not excluded; he sat in court for thirteen days. It is hard to think, for a man who gave up his work that long, and who had so much at stake, that he was so conscientious that he did not communicate fully with prospective witnesses, regardless of any instructions. His ultimate appearance on the stand did not impress me that favorably.

It is true that the Bruces also attended throughout, but they did not have the panoply of witnesses to prepare. It is also true that Ferreira had an absolute right to be present. I draw no inference from the mere fact that he exercised it. However, I have given a great deal of thought to the fact that it was defend-

ants' counsel who requested that the witnesses be excluded. Plaintiff's only witnesses, other than the Bruces themselves, who were not excluded, were Calnan, whose testimony was already substantially contained in his affidavits, and Mr. Williams. Why would counsel want his own witnesses excluded? Could it be so that the court would be impressed by their "cold" testimony? But who was in court throughout, and exceptionally able to keep future witnesses informed, but a most interested possible stage director? Or might counsel have feared that some of these witnesses were only too ready to shape their testimony, and would so appear?

I have a lingering discontent. And particularly I reject counsel's intended implication that it is "remarkable" that certain witnesses were so corroborative of each other. Since the group included Souza and Lynn Perry who, even standing alone, were most unimpressive, my response as to what is to be remarked is not what counsel intended.

As to the Bruces, although I have some problems that I shall come to, I rather took to their good character, and ascribed some, if not all, of Walter's testimonial deficiencies to age. Nothing about them, however, has shaken my view that, largely, it is the Bruces against the world, not only theoretically, but practically.

To turn to defendants' witnesses individually, I received a firm impression from his demeanor that Robert Souza was unworthy of credit.[5] He was outdone by his wife, and from her I never recovered. Firmly planted and immovable, except

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[5]One very small example: Captain Maillet testified that Edward Perry and Walter Bruce "delivered to the boat" the first compliment of banana skins. This corresponded with their own testimony, except for the date. Souza testified — not led — to Maillet having brought them himself in his truck. If he had said he could not remember, that would have been not only quite understandable, but most likely. I believe it sounded better to his "understanding" to have Perry out of the picture.

when asked unexpected questions on cross, she recited a well rehearsed part. The payoff was when asked, on cross, whether she had discussed her husband's testimony with him after he had testified two days before, she said no, which was well enough, but then smugly volunteered that she had talked before, but not after. She had learned her lesson well. I do not believe that Mrs. Souza tripped over a bag on deck that conveniently opened and spilled out what she was educated enough to recognize as banana skins. The heralded written "confirmation" confirmed nothing except to establish a date for banana skins too early to make good sense. Both Souzas testified to banana skins on the Donna Lynn in 1978. It is preposterous that this could be, when general use did not begin until November, 1979, and even defendants' other witnesses placed the tests as the summer of 1979.

Another witness who appeared to have rehearsed his piece to perfection was Richard Rose. Like Mrs. Souza, he was dressed for the occasion, and while it could have been taken as an indication of special respect for the courtroom, my total impression was one of theatricals. My trial notes read: "Quick, responsive; very self-assured; too well on top of everything not have been rehearsed to the nth degree, until end of cross." If there had been testimony that Rose, and perhaps Mr. Souza, had a financial interest in the case, I should have unhesitatingly believed it.

Next, I do not believe Lynn Perry, who, incidentally, among other unlikely accounts, testified that Robert Souza had to be brought home from two different boats because of attacks of bleeding ulcers; a story unsupported by anyone else, and contradicted by Mrs. Souza, but which he doggedly adhered to. This is the witness, who, by deposition, believed a bellyband was "a long chain shackled to the chain bag with rubber discs all along it," before his memory had been refreshed by Robert Souza.

Equally remarkable, defendants' employee, Trusis, whose interest in banana skins had to be pumped up, was able to notice them on board a vessel from his new automobile, again in 1978, "confirmed," no less, by the bill of sale. I do tend to believe that an event occurred, but, if so, I would find that what Trusis saw were short pieces of bellybands, arranged up and down, which, in fact, might attract his attention, as it had been his job to make long ones. This is consistent with other up and down evidence, but that there should be banana skins at that time makes no sense. I further find that Trusis picked a banana skin from the then pile of exhibits, rather than a short piece of bellyband, as the result of careful coaching, presumably by his employer, Ferreira. I make the same finding with respect to what Mrs. Souza saw, if there was any truth in her story at all. There is too much difference in the appearance of the two articles for this to have been an honest confusion.

On a par with defendants' claim of remarkable corroboration is their repeated claim that vigorous cross-examination did not shake certain testimony. It is often relatively easy to adhere to a simple falsehood. What cross-examination did reveal were various other inconsistencies, confusion and improbabilities.

So far I have said nothing about the innumerable quantities of corroborating sales records. Only by elaborate arguments, far too elaborate to be appealing, do the records, or occasional absences, offer any modicum of comfort to defendants. What is important about the records to me is that the search was sparked with the hope of finding errors or omissions that would allow arguments supporting defendants' manufactured testimony. Defendants have had their "day" in court; it has been unproductive, and, because of the background, regardless of who wins, I shall consider, when I come to counsel fees, that it should never have been so engaged in.

There is a fallout to these things. I have reached the overall conclusion that defendants' case as to early use of banana skins

was staged and managed by Ferreira (not too adroitly), and I discredit it wholesale, quite apart from the burden plaintiff urges is on a defendant when seeking to show voiding prior use by oral testimony alone.

Ferreira himself was not a man that inspired me with confidence. Quite apart from his producing a witness who testified to 1978 use of banana skins, I was shocked that he should answer interrogatories on the all-important royalty question by omitting sales outside the Commonwealth. Counsel would cover this up by pointing out that he corrected his answer shortly. Of course he did; you cannot say it is not your hand found in the cookie jar. Ferreira was at least candid enough to admit that he gave those figures at a time when he was hoping to make a favorable settlement, although he claimed it was all a misunderstanding.

This is not to say that all of defendants' witnesses were dishonest. I do not believe Normand Maillet was intentionally inaccurate, but I early made a note that he did not know whether he was afoot or on horseback. But there are much more deficiencies in defendants' case than fairly explainable by confusion, lapse of time, and poor memories. I find that banana skins were not used earlier than plaintiff concedes in October, 1979, and, accordingly, turn to the question whether this use was experimental within that exception.[6]

My almost total disbelief of defendants' witnesses leads me to agree substantially with plaintiff's, both that first uses were with Calnan and Perry in October, 1979, and that they were truly experimental. It is interesting to look at Edward Perry, one of the two patent affiants. On his oral testimony his vessel

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[6] A footnote should perhaps be devoted to the note in Mr. Williams' file to the effect that local counsel told him the first date was July, 1979. I find this was a mistake, perhaps due to a misunderstanding of when Wayne Bruce first began to think of the concept. If it had been, on consideration, correct, obviously Mr. Williams would have acted differently.

GERALDINE made three runs; he regarded all three as experimental, even though after the second he felt they "looked good;" "had a potential." He offered to pay, he wanted them so much, but Walter "just said keep trying it because, I guess he didn't seem to think they were working." It is to be noted that this was on direct examination, called by defendants.

Edward Perry, if believed in toto, would be fatal to plaintiff because he placed the three trips in late spring or early summer, 1979, corresponding with Maillet and others. It is easy to believe he was persuaded. Quite apart from the Bruces' invoices, it is not so easy to believe that these dates were confirmed by records he had "at home."

These were fishermen type, and not IBM experiments, and defendants' protest that there were no written records kept, and no formal agreements, is an affront to the court's intelligence. Nor was there any need for express promises by Calnan and Perry not to sell to anyone else. The examiner said he "understood fishermen," and so do I. Certainly such was implicit; they did not have enough for themselves, nor were they reusable. Nor, given the common dock set-up, with "rafting," could there be an agreement to keep fully secret; publicity was perhaps unavoidable. I attach no legal significance to the fact that Calnan and Perry volunteered to pay (the "mounting costs" was stupid language — it was simply arithmetical); or considered they owned them. After all, these were consumable goods. Moreover, I am more interested in the Bruces' state of mind than the users'.

Finally, I am not impressed by defendants' argument that this was "market" testing, not inventive testing. The awaiting demand was obvious. If the device did not work, and attachment was a serious problem, it was not an invention; if it did, it was an invention and marketable.

I further accept plaintiff's testimony regarding the shingles. The simplest way to recite it is that I believe the basic sub-

stance of the affidavits. I am not happy about some of the theatrics. Their detail compares unfavorably with the lack of disclosure in other papers filed, but this does not make them inequitable. The accumulated fault, I distribute. It would be natural for drafting counsel to be as appealing as was fair. He had had a lengthy conference, and I believe his honest intent when he forwarded them was that affiants should examine them carefully.[7] It was naive, however, to think that laymen of the rough-and-ready type that the Bruces and affiants obviously were would exercise the meticulous care called for with regard to papers drawn by a lawyer.[8] However, I do not find as many discrepancies as defendants would have it. On the evidence that I believe I find no material or substantive misleading, although, superficially, the affiants were very lax.

Defendants make two basic mistakes about the affidavits; three, in fact. The first is the assumption that their own witnes-

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[7] *See, e.g.*, letter to Walter Bruce, "As you are no doubt aware, these affidavits will be closely scrutinized by the other side when a lawsuit is brought so it pays now to take great care in making sure our statements are accurate and supportable."

[8] For example, Edward Perry testified,

> Q. Well, did you read this affidavit carefully when you signed it?
> A. I would — well, I didn't scrutinize it. I read it.
> Q. You didn't study —
> A. I'm not a lawyer.

How many lawyers would be surprised by such testimony?

ses are to be believed. Secondly, they argue at length, which must be obvious, that the PTO relied on them, but from this they would draw the conclusion that everything said was material. Of course this is not so. But, most fundamental, there is an underlying assumption, that would be erroneous on its face were it openly expressed, that there was no need of experimentation. If reference to mythology may be pardoned, the Bruces' concepts were not like the birth of Venus, rising from the sea fully formed and perfect. Rather, experimentation and improvements were to be expected as a matter of course. I find the Bruces were assiduous in doing just that, and at the time they said they did. I find the testimony offered in contradiction both false and unreasonable, and cannot help believing that much was consciously false. In sum, I find that reduction to practice did not occur until November, and that defendants fail with respect to untimely filing. I similarly accept the Bruce's favorable testimony with respect to the second patent.

I turn now to a more difficult matter, commencing with the meaning and effect of the following statement, in both applications, under the heading "Background of the Invention."

> "It has been attempted to use sections from other damaged bags attached beneath the chain bag to extend the useful life of the bag but this has added unnecessary weight, making equipment more difficult to handle."

This statement stands alone; viz., there is no reference to bellybands. Defendants say that this is, in effect, a denial of their existence.

The presence of an implication, making a statement an untruth if the implication is false, depends upon the understood circumstances. "There were just two handsome men in church

today," may be a simple statement of fact; viz., that of all the men present, only two were good looking. If, however, at issue was the low number of male communicants, the statement could be thought false if there was no separate disclosure of the existence of the a dozen men who were not handsome. On the other hand, if the issue was the low proportion of handsome male churchgoers, the implication might be false if these two were the only men present.

I read the background statement as saying that old chain bags were the only, or, at least, the most relevant prior art against which the device was to be measured as improvement, and find this was what an examiner, concerned with the prior art, would conclude was meant. If not, what other purpose? The natural inference would be that there was no equally relevant prior art, let alone art of greater closeness not subject to the criticisms directed against the art mentioned. This interpretation, moreover, exactly fits counsel's understanding when he knew nothing of bellybands, and had been told by forwarding counsel's letter following up their initial conference, "[M]y clients indicate that it is not very common for fishermen to use old pieces of worn-out chain bag as chafing gear, but a few have done so in the past."

I remark, in passing, that although I credit the Bruces' testimony that they had forgotten what little they had been told about up and downs, because short pieces were often used to piece out crosswise, it is hard to believe they were fully candid with counsel, who they wanted to retain to put their best foot forward, in not telling him of crosswise bands.[9] It

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[9]The content itself of the quoted statement drafted on counsel's understanding, based on specific quotation of the Bruces by forwarding counsel, was inaccurate. "It has been attempted to use sections from other damaged bags . . . ." — viz., even old chain bags were just a sometime attempt. Yet, on the stand, Walter Bruce testified, "[T]hey have been used since all of us have been in business. No one threw an old chain bag away."

was only after counsel had seen the invoices, and was making more specific inquiry, in June, 1981, on which to prepare affidavits, that the story came out — effective rubber chafing gear, beginning with the bellyband, was one, continuous, pursuit. Walter Bruce considered the crosswise band a great improvement over old chain bags. However much a banana skin may have been an improvement over the crossband, I find it hard to understand how they could think an examiner considering the alleged invention would want to know about old chain bags but not feel it important to know there was a significant intermediate step between them and their proposed device.

However, faulting the Bruces has become moot because, in sufficient time to correct any error, counsel was given the full picture with respect to the crosswise band. Unfortunately counsel concluded there was no need to pass on the information.

For present and future purposes I note the following excerpts from the record of the June 12, 1981 conference between counsel (W) and Walter Bruce (B).

> B. They [the bellybands] worked good. . . . The drawback was they were hard to pull because the edge dug in and plow (sic) into the bottom. They were harder to tow for the small boat. . . . They worked better than the old chain bag. The old chain bag was very good until this came along. . . . [T]he small boats, they could not use it; they were causing too much friction on the bottom for pulling purposes. . . . These are the edges that raise hell. . . .
>
> B. They asked me if I was trying to find something in the rubber thing to offer them something to save the bags from chafing.

The only explanation, if it be called such, that Walter offered on cross-examination for telling counsel of old chain bags but not of bellybands, was "I don't know why, except that if he had asked me about it, I would tell him about it."

W. Was this back before bellybands?

B. This was back the belly bands. So we came out with belly — so we got the tires. They see me cutting the stuff, and they say this will be good if we could find some way of attaching it to our bags. And we tried, and we tried. And from there, they said that's very good, but there must be a better one. So then we come up with the strips. . . . The strips didn't work because they weren't applied right. Then finally the strips were applied right. . . .

W. And you were still experimental?

B. We were still experimental all the time, till we finally hit this one. [shingle]

Again, B. The best ones that we could develop are now present on the bags, and they're terrific, and they can't pull off.

Before considering defendants' claim that counsel's failure thereafter to inform the PTO of the crosswise bellyband was inequitable conduct voiding the patents, viz., gross negligence,[10] I start with the scope of invention, in fact, and as claimed. At least during the reargument plaintiff asserted — the court having stated that it was only in the course of preparing the August 29 opinion that it had realized plaintiff was claiming banana skins attached outside the bag — that this had always been its position. The fault was mine in not earlier studying the individual claims more closely,[11] but everything else in the record ran the other way.

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[10]The issue is not counsel's subjective, but his objective conduct, viewed in light of the degree of materiality (as it should have been realized) of the undisclosed matter.

[11]That outside attachment is claimed, see and compare claim 2 with claims 1 and 4, and claim 14 with claims 12, 13 and 17 in the '972 patent, and claim 4

To begin with the patents themselves, nothing within their four corners apart from the claims suggests omitting the inside attachment. The Summary of the Invention reads,

> By disbursing the leading ends of the strips within the chain bag, the forward edge and corners of the strip *are* protected from catching on the ocean floor. (Emphasis suppl.)

This was proceeded by an Abstract, stating,

> [The] strips . . . *are* attached to the chain bag in a manner that protects the forward edge and corners of the strip from catching on the ocean floor while allowing the longer portion . . . to trail beneath the chain bags. (Emphasis suppl.)

It is to be noted, with respect to both of these descriptions, that the drafter knew the difference between the positive "are," and the permissive "can be." *See* col. 2, l. 5, of the '972 patent.

While, concededly, neither an abstract nor a summary necessarily state all of the alternatives or ramifications of the invention, protection of the leading edge is repeated throughout. Nowhere, apart from the claims, is there any suggestion that the invention is simply a piece, or a number of pieces, of rubber to be attached in an unprotected fashion. Plaintiff says that it is the "preferred embodiments" that show an inner attach-

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with the others in '629. One who fails to make this comparison might carry over generally the Summary description and the frequent specifications for protected attachment.

ment, and that as a matter of law an invention is not limited to preferred embodiments. The principle is correct. However, it is to be noted here that all embodiments described as alternates, both in language and drawings, except when illustrating an individual banana skin, unattached, also show inside attachments, the differences being in the method of attachment, not the location.

Nothing different would be learned by resort to the file wrapper. The affidavits of Calnan, Perry, and the Bruces refer, solely, to the testing of figures 4 and 4a, both of which plainly show inside attachment.

Nor does the record indicate that counsel himself was given any broader description. Plaintiff points to his original conference with forwarding counsel, including the correspondence. This makes no reference to methods of attachment, one way or the other; it was simply for the purpose of a broad patent search. The significant information is in local counsel's June, 1980 letter, which concludes as follows,

> The process in which the chafer is connected to the chain bag is by locking it on the second or third row of chains and then tucking the strip underneath the fourth row so as to lock it into place. Pictures of how it is attached are numbered 8 and 9.

Pictures 8 and 9 clearly show inside attachment.

And, finally, counsel, ultimately, received Walter Bruce's June 1981 account, some of which is quoted ante, (*e.g.*, "The strips didn't work if they were not applied right.") and all of which extolled the advantages of the banana skin's eliminating the protruding leading edge. This was reflected in the Bruces' affidavit of June 31, 1981, submitted to the PTO, and to be found in both file wrappers.

> The experience of the prior fastening methods being pulled through the rubber indicated that an effective method of fastening the chafing gear to the bags was first priority.

It was also reflected in the cross-examination of plaintiff's counsel at trial.

> Q. Wasn't one of the important concepts in the invention for which you [Williams] were seeking patent protection, an arrangement in which you were trying to protect the leading edge of the rubber strip from catching?
> A. That was part of the methods of attachment.
> Q. That was part of the problem that you were trying to solve?
> A. Yes.

Correspondingly, Plaintiff's Brief After Trial states, "It is the way the material is attached to the bag that is important."

I find it impossible to believe that, until counsel fragmentized it, the banana skin invention was thought of other than inside-attached.

It is true that, at trial, witnesses testified that, in practice, fishermen did not always bother to make inside attachment and Calnan testified that they worked just as well. This I simply do not believe. Rather, I believe Wayne Bruce, who said that fishermen's persisting in making outside attachments gave him a "problem." I interpret this to mean that their resulting shorter life gave banana skins a bad name.

Finally, on this subject, if it could be thought possible that a banana skin, if cut sufficiently narrow to be usable as a pre-

ferred embodiment, *viz.*, "tuckable" inside the bag, would stay on with outside attachment well enough to constitute an invention, because of less leading edge, the broad claims did not limit width. It is true that the specifications with respect to the preferred claims did — narrowness being required for insertion into the bag — but there is nothing to indicate that claims which abandoned inner attachment necessarily retained its constricting width. Rather, I read the broad claims as covering full-width up and downs, except that, because of the single attachment, they would lie in a different direction.[12] Plaintiff at one point conceded this, but ultimately rejected it, seemingly on the ground that the attaching links, or means, could not operate if the tread was too thick. How thick the tread must depend on the individual used tire. Moreover, the center part of an up and down, where must be the single attachment, would appear to be less thick than the edges. Plaintiff's sought distinction here is not taught.

Nor can I believe an outside-attached up and down with a single attachment (and the only evidence on the subject was testimony that this did not work, nor did counsel have any pre-patent information that any outside-attached banana skin worked) could be thought inventive over a bellyband. Every little improvement is not invention. I further believe this would be an obvious modification.

Plaintiff contends that direction was a variation not obvious to persons in the field because they had a low level of sophistication, and that it is obvious only to Monday morning quarterbacks. This customary call of the disappointed inventor does not carry in light of the fact that fishermen had already devised up and downs. This, even though counsel was ignorant thereof,

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[12] I reject out of hand defendants' contention that a provision for one attachment did not mean that a user could not add another, changing the direction, so that the broad claims would cover a crosswise band.

would seem the best possible evidence of obviousness in fact. Nor do I think it inventive because, with a single attachment, it was easy to replace broken rings underneath.[13] In this rough area, where fishermen are bound to improvise, this is a refinement that I cannot conceive of as determining invention.

In sum, I think it grossly unreasonable to think that an outer-attached banana skin, with no definition of size, would be inventive over a bellyband simply because it trailed from a single attachment, or for experienced counsel to think so. My only reservation is that the cases speak of the necessity of the court's being "convinced." I am perhaps not "convinced," and, accordingly, withdraw that portion of my August 29 opinion. However, I am convinced that it was grossly unreasonable to think that a reasonable examiner, faced with a claim for such a broad device, would not think it important to know of the bellyband, which had established that old tires, as long as they stayed on, "worked good," to quote Walter Bruce. Here I start with my finding (as to which I *am* convinced), that the recitation of the attempted use of old chain bags would lead a reasonable examiner to think that rubber had never even been tried, or, if it had been, had not worked. Plaintiff's contention that the examiner, because familiar with the waterfront, knew of boats' use of rubber for chafing, proves too much. Would not such a person be likely to wonder why it was not being used on scallop bags? If so, he would find a ready answer in the Bruces' affidavit, that the priority problem was attachment. He is thus, in clear effect, told that the banana skin was the first practical solution. In point of fact, as Walter

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[13] Plaintiff would also attach significance to the sometimes used phrase "array of strips." I do not agree that this necessarily means a large number, or that a large number is inventive. I take "array" to mean placement, *viz.*, not helter skelter, or *dis*array, but, again, I do not think a pattern, in itself, to be inventive. The concept of overlapping is old and universal.

Bruce made clear to counsel in June, 1981, the banana skin was the second successful step, an intermediate advance towards his ultimate goal of the prefect chafing gear. The question, so far as the broad claims were concerned, would be whether it was a sufficient step to be independently inventive when, as with the bellyband, the attachment still remained outside the bag. Even if I should be thought mistaken in believing this would not be, that such a conclusion is at least plausible warrants a finding that an examiner would consider knowledge of the bellyband to be highly important. I disagree with plaintiff's contention that the materiality of the bellyband was minimal.

Without suggesting the order of importance, I note three special advantages of not disclosing the bellyband. 1. As already mentioned, applicants were able to criticize old chain bags, to their benefit, as only sometime attempts, and as adding "unnecessary weight, making the equipment more difficult to handle." Rubber is lighter than steel. This maximized applicants' achievement. 2. Advancing rubber as a new concept in this area, avoided any possible "crowded-field" restriction. 3. If the bellyband could be thought damaging to an outer-attached banana skin, it would be easier to defeat it if the first encounter was in court, because here plaintiff would have the benefit of the presumption of validity. Counsel could not have been unaware of these three factors. In fact, plaintiff's initial brief began with a discussion of the strength of the presumption.[14]

Counsel testified that it was a formed judgment not to disclose the bellyband, and plaintiff argues that a mistake of judgment is not enough. This is an overstatement. Were it not,

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[14] In this regard I must remark that I have never understood counsel's volunteered testimony that he knew defendants would raise the bellyband at trial, and that in the meantime he would save burdening the examiner, and expense to his clients. I speak more than personally in saying it is far better, for many reasons, that an examiner be burdened than the court.

every non-disclosure could be labelled a judgment call. I must reget criticizing counsel's judgment, but there must come a point where the rule's requirement of informing the PTO of all matters a reasonable examiner would think important would become meaningless. The PTO, perforce, relies on counsel for information, and it is the PTO, not counsel, that decides whether there is invention or not. I was receptive to accepting, as at least not grossly unreasonable, counsel's screening when I had mistakenly thought the patents claimed only the real advances over the bellyband in function and wear achieved by recessing the leading edge, as described in the abstract and summary, but, in light of the broader claims, I find it totally unreasonable to have let stand the "background" of little used old chain bags, and make no mention of bellybands after counsel learned of them. In fact, I think the bellyband so relevant that its omission would be grossly negligence in any event, but the then isolated account of old chain bags accentuated it.

The bellyband's disclosure, I may assume, was not needed for the shingle claims, which I consider clearly inventive, but, unhappily for plaintiff, if there is a substantial leak, the whole ship sinks. This is the law, and I must consider this case on the basis that the validity of a patent is a matter of public concern, beyond the parties. Judgment must be entered declaring both patents invalid. Prior thereto I will receive briefs, on or before December 4, 1985, as to both parties' claims for attorney's fees and costs (in principle, not in amounts), and thereafter, if the parties wish, hear oral argument.

Aldrich

Senior Circuit Judge*

*Sitting by designation.

Appendix C

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

CIVIL ACTION
No. 82-2220-A

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS.

Memorandum and Order on
Motions for Attorneys' Fees, etc.,
December 27, 1985

This suit for infringement of two patents, with counterclaims for a declaration of invalidity, raised many issues. Defendants at first denied infringement, and ultimately alleged late filing, fraudulent misrepresentations to the PTO, and inequitable conduct in failing to disclose prior art. There was extensive discovery. Before trial plaintiff filed disclaimers with the PTO of a number of claims in both patents. It also sought, unsuccessfully, to dismiss herein all the remaining claims of the first patent.

The principal issues at trial were defendants' claim of late filing, and of inequitable conduct before the PTO, the latter

divided between allegedly false affidavits, and failure to disclose prior art. Plaintiff weathered all except the last, and even here it foundered only in a manner that had not been initially threatened — failure to disclose the crosswise bellyband as distinguished from bands known as up and downs. Following the opinion of November 13, 1985, both sides seeking attorneys' fees, expenses and costs. Since defendants were the prevailing party, I consider them first.

Under 35 U.S.C. § 285 the prevailing party may be awarded fees in exceptional cases. Defendants say fraud is a classic example. The inequitable conduct found here was gross negligence and not fraud in the common law sense. I consider the degree of inequity of significance, especially since fees, if awarded, are based upon a theory of compensation. I find myself in full agreement with plaintiff that defendants have not shown themselves to be particularly deserving of special compensation. The principal claim on which plaintiff sought recovery was the inner-attached so-called shingle. I find that if full disclosure of the prior art had been made, that claim, most probably, would have been rejected. The non-disclosure related primarily to other claims, and plaintiff has lost as a direct or indirect consequence of claiming too much. *J. P. Stevens & Co., Inc.* v. *Lex Tex Ltd., Inc.*, 747 F.2d 1553 (Fed.Cir. 1984). I further find from defendants' behavior, regardless of what their counsel seeks to protest, that it is highly likely that they would have infringed and litigated in any event, and have sought to escape by unfounded allegations of inequitable conduct, in the same pattern. This is peculiarly a case where the inequitable conduct was not a cause of the lawsuit. I do not find it an appropriate case for awarding defendants attorneys' fees.

Quite apart from this, defendants have so prejudiced themselves by their own conduct that it would be inequitable for them to be awarded fees even if otherwise they would be en-

titled. I will outline this conduct in connection with plaintiff's crossclaim for fees.

Plaintiff cannot claim under section 285. However, even as a loser it is not barred under general equitable principles. *McEnteggart* v. *Cataldo*, 451 F.2d 1109 (1st Cir. 1971). Defendants' behavior with respect to their defense of prior use, commented upon at length in the November 13 opinion, I find shocking. In many cases that reach trial the trier must conclude that one party's witnesses, or the other's, are not telling the truth. However, this need only be the more-than-likely-than-not test, and one might hesitate before being entirely certain that the selection was the correct one. Here I am satisfied beyond a reasonable doubt that the defense on this issue was not made in good faith. As previously found, the undocumented testimony as to 1978 prior use made no sense, and was irreconcilable with everything else in the case, defendants' as well as plaintiff's. It is not to be discounted by defendants' present suggestion of possible poor memory. Defendants did not previously suggest erroneous memory. Instead, in their post-trial briefs, even after viewing the whole case they persisted in relying on this testimony. If poor memory is to excuse a wrong date, why did defendants call Mrs. Souza for the asserted express purpose of corroborating Mr. Souza, and have her testify, "Definitely in June of '78," with an allegedly "confirming" paper?

Even less acceptable is defendants' claim that the Souza's 1978 date "first . . . occurred in *cross*-examination . . . by plaintiff's attorney." (Emphasis in orig.) Quite apart from the relevance of such circumstance, it is to be recalled that not only was Robert Souza the primary witness advanced in defendants' pretrial brief, but by defendants' answers to interrogatories his 1978 date was already disclosed. Much else was disclosed. See Plaintiff's Trial Brief filed 12/14/84, p.53 (a document, part of which falls within my order herein).

I do not like to run this matter into the ground, but I have been taken aback more than once by defendants' brief on fees. "Contrary to Plaintiff's contentions, Defendants at no time or for any of its defenses relied upon uses of banana strips in 1978." What kind of a statement is this from counsel who had called, for example, defendants' employee Trusis, whose sole testimony of any significance was his alleged viewing of banana skins aboard ship in April, 1978, again "confirmed" by a non-confirming paper? And what type of inverse logic is demonstrated by defendants' assertion, "Plaintiff, not Defendants, relied upon the 1978 uses to demonstrate the alleged unreliability of Defendants' witnesses."? Are defendants to be excused from paying counsel fees to refute this false testimony because plaintiff used it to show the claim was false? On reflection, I must find counsel's statement at the oral hearing on this matter, that he "didn't want" this testimony, very difficult to accept. Quite seemingly, his disaffection arose after it became the linchpin of my unfavorable reaction to defendants' whole case on prior use. Nor did the allegedly corroborating invoices generally presaged in the pretrial brief add up to anything.

Defendants' attempt to show that the admitted October 1979 uses, which I have found to have been experimental even though there were payments, were not such, does not suffer this condemnation. With this exception I consider defendants' claim of prior use of banana skins an unabashed fabrication.

Nor does the 1978 falsity stand alone. Ferreira's trial explanation that his extraordinarily insufficient interrogatory answer as to 1982 sales was due to a misunderstanding as to what purchasers were inquired about cannot wash. The question was unambiguously phrased. Moreover as, allegedly, construed, it would have been a meaningless question. The explanation is matched by the excuse, now proffered at length, that plaintiff had the records and could have gone through

them. The inference to be drawn from a false answer is not dispelled by the fact that there were means available for discovering the truth.

There remains the question whether plaintiff has forfeited an award of fees by its own conduct. Quite possibly this should be the effect of conscious impropriety. I have not found such; indeed I suspect that even today, although they have not proclaimed sincerity as counsel for defendants has, plaintiff's counsel subjectively believe my decision erroneous. Be that as it may, I do not find plaintiff's action of the type to offset what I have found to be defendants' conduct. I am particularly surprised that defendants, who knew from plaintiff's brief before trial that Attorney Williams had known of the crosswise band, but made little or nothing of it during trial, now say his conduct was "egregious." The fact is that the degree of plaintiff's counsel's negligence was developed only by the court itself, following trial, the court believing that the validity of patents, vel non, and the application of settled rules, are of public concern even if the defense was insufficiently presented. It is interesting that what counsel could not see before, he now sees as egregious.[1]

---

[1] Egregious means, "Conspicuous for bad quality." Webster's New Internat. Dict. (3d ed.). Since it evoked a vigorous protest by plaintiff during argument I deal with its complaint to the following quotation from defendants' brief.

> "In the present case, the conduct of plaintiff's counsel was particularly egregious. Not only was counsel responsible for withholding information *that he admitted should have been given to the patent office* during the prosecution of the application, but also his role *in that misconduct* was concealed from the patent office despite the filing of a reissue application." (Emphasis suppl.)

The court joined in supporting plaintiff. Following argument defendant supplied the court with the transcript (with which the court was highly familiar), the significant part of which reads,

Rule 11. Defendants' initial Brief on Attorney Fees describes the rule as follows.

> "Rule 11 was amended in 1982 to expand *significantly* the responsibility imposed on attorneys when they sign pleadings or motions . . . widespread concern over frivolous litigation and abusive practices of attorneys led to the amendment in 1983 of Rule 11." *Coburn Optical Industries, Inc.* v. *CILCO, Inc.*, 226 USPQ 1018 (M.D. N.C. 1985), citing *Roadway Express, Inc.* v. *Piper*, 447 US 752, 757 n.4, 100 S Ct., 2455, 2459 n.4, 65 L Ed 2d 488, 495, n.4 (1980).

This omits the rule's now inclusion of "papers." I am unsure whether papers include briefs.

I see no basis for defendants' charging plaintiff's counsel with Rule 11 violations. Nor defendants' counsel, either, unless he was satisfied that his witnesses were not speaking the truth. Not to be flip about it, this would be to suggest not only that counsel coached the witnesses, but did a poor job of it. I make no separate finding under Rule 11.

Costs. Continuing to quote defendants' briefs, it is their view that the proper standard (although they would apply it against plaintiff) would be "taxing . . . costs related either

---

"In retrospect, I think I could have called that the other way, yes. . . . Maybe I made a mistake, Mr. Wolf, I think I did."

This can very fairly be construed as a realization of negligence, but I find it very difficult to equate with an admission of "misconduct," particularly in the connotation egregious.

directly or indirectly to . . . inequitable conduct." I adopt that standard. Defendants will be charged as follows.

1. All expenses, trial and pretrial, including all time spent by other than counsel, and all reasonable disbursements in connection with resisting all claims of prior use of banana skins, other than uses admitted by plaintiff and found to have been experimental. This to include employees of plaintiff, and paralegals.

2. Reasonable attorney's fees for all time spent by counsel in connection with the above.

3. Same as 1 and 2, excluding any overlap, in connection with depositions taken after Magistrate Cohen's order, except deposition of Edward Perry insofar as it related to the accuracy of his affidavit.

4. All time, expense, and counsel fees reasonably spent in preparing evidence and prosecuting, action for recovery of the above. This does not include November 14 — December 26, 1985.

5. Interest. The court suggests 10%, but will hear counsel if the parties cannot agree on this, or some other figure.

No other costs. I award none to defendant in part for the above reasons, but also because they lost on everything, except where the court took over.

Finally, the November 13, 1985 opinion is amended by striking out the initial paragraph on slip page 10, and the first line immediately following, and substituting the following.

I draw no unfavorable inference from the mere fact that Ferreira attended throughout the trial; he had an absolute right to be present. At the same time, it did afford him the opportunity to keep segregated witnesses fully informed, and, at the least, it undercut

My erroneous summer memory as to when plaintiff's counsel stated he was not going to call Edward Perry was jogged the wrong way by rereading defendants' pretrial brief, whose disclosure as to Perry's then memory seemed quite incompatible with the thought that plaintiff would call him. My error came to my attention during the recent oral argument. There was nothing possibly untoward in defendants' counsel's requesting segregation of witnesses when he was unsure whether plaintiff would call Perry as well as Calnan.

Aldrich

Senior Circuit Judge

Appendix D

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

CIVIL ACTION
No. 82-2220-A

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS.

MEMORANDUM AND ORDER RE: APPEAL

In deciding this case on the merits on November 13, 1985, holding invalid the two patents in suit, I recognized that possibly both parties might be entitled to attorney's fees, and requested briefs by December 4 as to merit and principle involved, not the amounts. Briefs were duly filed, followed by oral argument, and on December 27, with an eight-page opinion I entered an order calling for submission of amounts. Detailed submission would require considerable work, and I set no schedule. From time to time thereafter I inquired of the clerk, who made some reports, but I did not press counsel because I knew I was not available to deal with submissions.

Finally, in early May, I had the clerk notify counsel that June 15 would be the final date, so that I could attend to the mat-

ter in the summer recess. The response, filed June 10, was a joint motion to stay, as "the determination [of fees] at this time *would unduly delay* final resolution of the merits of this litigation." (Emphasis mine.)

I must ask, where have these expeditious-minded counsel been for five and a half months? I further note that a decision on the merits will not render negatory my order for fees, whichever way it comes down, as I charged fees against the prevailing party, who must thus pay either way, unless the Court also reverses my order on fees. I further note that the Court has said in other types of cases that it is best that the fee decision be made prior to the appeal.

Nonetheless, in part because patent attorneys are accustomed to appeal before there is a determination as to damages, and in part, I fear, because here it is June 15, and I have no submission before me, do not intend to work late into the summer. I allow the joint motion. The parties and clerk may prepare a judgment, noting this omission, and both parties (I assume) appeal. If the Court rejects the appeals as untimely, the parties may return here and shall not be treated as having lost rights.

I alert the Court, however, to this problem.

Aldrich, S.C.J.
By:
/sig/
Deputy Clerk
June 17, 1986

Appendix E

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

CIVIL ACTION
NO. 82-2220-A

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS.

Preliminary Response to Plaintiff's
Motion for New Trial
November 28, 1986

ALDRICH, Senior Circuit Judge. On November 24, 1986 plaintiff filed a further motion for new trial. The court was, and still is, aware of the possible problem that its reasoning presented to plaintiff. At the same time, at least as an aside, it suggests that plaintiff's surprise could not have been complete; the negative pregnant in the disclosure of old chain bags, simpliciter, was an audible undertone throughout the entire piece, and if the court, concerned with the public interest involved in a patent, detected a note not heard by counsel, this was not a whole new opera. But even treating plaintiff's original request to reopen with "new evidence [to] follow the lines of this brief" with liberality, the court found nothing suggesting it should change its results.

The court's opinion had been filed on August 29; the motion for new trial on October 2. The court did not consider that the ten-day rule applied. At the same time it did consider that the customary rule for specification of the detail of the new evidence, needed to show its materiality, was called for. "[T]he testimony of one or both of the Bruces and Williams as to what each regarded as the invention, what the Bruces communicated to Williams in that regard, and what the benefits were of the features of the broad claims," had all been gone into, and a motion for new trial that did not specify material alterations or additions was meaningless.

The present motion offers more specifics, in proper affidavit form, although even here these are recited as being only "some of the evidence" plaintiff would hope to prove at a new trial. Particularly at this late date, the court takes any proposed additional evidence as merely cumulative. A new trial is serious business, requiring a showing of cause. Plaintiff has had a year, plus ten days, to prepare it. Accordingly, the court takes plaintiff's proffer simply as a proposal to establish that banana skins functioned well even though not inner attached.

It is quite possible that, with the passage of time — the attacked opinion is one year old — the court's memory, or comprehension, has clouded. The papers in this case, with some duplication, occupy four full cartons. However, the court believes that it recognized from the beginning that banana skins were used other than inner attached. At the same time, its present recollection is contrary to Wayne Bruce's affidavit suggesting that he had understood "they worked just as well attached on the outside," or that his opinion as to the banana skin's advantages over the crosswise bellyband was with reference to that attachment. Nonetheless, the effect of this earlier understanding departed. In the November 13, 1985 opinion that was substituted for the August 29, 1985 opinion, appears the following.

> I start with the scope of invention, in fact, and as claimed. At least during the reargument plaintiff asserted — the court having stated that it was only in the course of preparing the August 29 opinion that it had realized plaintiff was claiming banana skins attached outside the bag — that this had always been its position. The fault was mine in not earlier studying the individual claims more closely, but everything else in the record ran the other way. (Footnote omitted)

Thereafter, following extensive discussion, the court accepted plaintiff's contention.

> In sum, I think it grossly unreasonable to think that an outer-attached banana skin, with no definition of size, would be inventive over a bellyband simply because it trailed from a single attachment, or for experienced counsel to think so. My only reservation is that the cases speak of the necessity of the court's being "convinced." I am perhaps not "convinced," and, accordingly, withdraw that portion of my August 29 opinion. However, I am convinced that it was grossly unreasonable to think that a reasonable examiner, faced with a claim for such a broad device, would not think it important to know of the bellyband, which had established that old tires, as long as they stayed on, "worked good," to quote Walter Bruce.

Now at issue, defendant having, as plaintiff points out, lost on everything else, is the court's finding of inequitable conduct

on counsel's part. The court is at a loss to think how the present motion should affect this. This may be the court's fault; it invites oral argument, and, if desired, further briefing, but, it hopes, with some expedition.

Appendix F

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

CIVIL ACTION
No. 82-2220-A

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS.

ORDER
December 22, 1986

Plaintiff not having responded to the court's Preliminary Response filed November 28, 1986, and the court not having changed its mind, plaintiff's motion for new trial filed November 24, 1986 is hereby denied.

By the court,
George F. McGrath, Clerk
/sig/
Deputy Clerk

Appendix G

United States Court of Appeals

for the Federal Circuit

87-1142, 87-1172

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF-APPELLANT,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS-CROSS-APPELLANTS.

JUDGMENT

ON APPEAL from the United States District Court for the District of Massachusetts

in CASE NO(S). CA-82-2220-S-A

This CAUSE having been heard and considered, it is ORDERED and ADJUDGED:

AFFIRMED.

ENTERED BY ORDER OF THE COURT
DATED DEC 22 1987

/sig/
Francis X. Gindhart, Clerk

ISSUED AS A MANDATE: February 10, 1988

A True Copy.
Attest: February 10, 1988

/sig/
Deputy Clerk

Appendix H

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

CIVIL ACTION
No. 82-2220-S-A

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS.

JUDGMENT
November 13, 1986

The issues of validity, infringement and unenforceability of U.S. Patents Nos. 4,349,972 and 4,328,629, having been tried to the court, and in accordance with this court's opinion of November 13, 1985 and memorandum and orders of December 27, 1985 and June 17, 1986, it is ordered, adjudged and decreed:

1. The court has jurisdiction of the parties and the subject matter.

2. Claims 2, 8-11, 15, 16, and 18 of U.S. Patent No. 4,349,972 are valid.

3. Defendants have infringed valid claims of U.S. Patent No. 4,349,972.

4. U.S. Patents Nos. 4,349,972 and 4,328,629 are unenforceable.

5. The complaint is dismissed with prejudice and defendants' prayer in the counterclaim for a declaration of unenforceability of the aforesaid patents is granted.

6. Costs and attorney fees shall be awarded to plaintiff in accordance with the memorandum and orders of December 27, 1985 and June 17, 1986. Proceedings to ascertain the amount of such award are stayed in the event this judgment is appealed until disposition by the Court of Appeals, or in the event there is no appeal, until the final date for appeal has expired.

By the court,
George F. McGrath, Clerk
/sig/
Deputy Clerk

Enter:
Aldrich /sig/
Senior Circuit Judge*

Entered on docket November 14, 1986

*By designation.

Appendix I

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

CIVIL ACTION
No. 82-2220-S-A

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS.

MEMORANDUM RE: JUDGMENT
November 13, 1986

ALDRICH, *Senior Circuit Judge*. The court apologizes at the outset for the delay in the entry of this judgment. Unfortunately, perhaps because its mind was occupied with another, complicated pending patent case, the court entirely forgot that briefs were to be filed in this one on August 15, 1986. Due to a breakdown in communications, it did not receive the filings until its permanent return to Boston in November. This it very much regrets.

The present dispute is over whether the judgment should be limited to enforceability (the court agrees it misspoke itself on page 32 of its opinion of November 13, 1985 — the word

"invalid" (by reason of inequitable conduct) should have read "unenforceable"), or whether it should include a determination of validity and infringement. Plaintiff wishes the latter; defendants, the former.

The court rejects defendants' contention that the latter would be legally impermissible. Appellate courts have frequently expressed the wish, for example, that the district court rule on validity even though it bases its decision on non-infringement — this in the interest of a possible ultimate saving of time. It also rejects the broad contention expressed in defendants' August 12, 1986 memo,

> Such inclusion [valid and infringed] is premature because this Court has not made specific findings with respect to all of defendants' invalidity defenses and the Court has not made specific findings as to infringement. We read the opinion of this Court to suggest that it had not determined that all claims of both patents in issue were valid, nor do we believe that the Court had found it necessary to focus on the issue of whether all products offered for sale infringe all claims.

Plaintiff's previously proposed judgment warranted some of this criticism. However, plaintiff now proposes the following.

> 2. Claims 2, 8-11, 15, 16 and 18 of U.S. Patent No. 4,349,972 are valid.
> 3. Defendants have infringed valid claims of U.S. Patent No. 4,349,972.

At the outset of trial defendants stipulated to infringing some claims of the '972 patent, provided they were valid.[1] Hence, the only real question relates to validity, viz., insufficient findings as to "all of defendants' invalidity defenses," ante. Review of Defendants' Trial Brief reveals two: obviousness, and that the Bruces were not the sole inventors. The latter claim is frivolous; that others helped in the experiments did not make them co-inventors. As to obviousness, the court has already found the shingle to be "clearly inventive." If, in view of the very obvious evidence, this needs to be spelled out, the court finds that the protected leading edge, the simple method of attachment, the general combination of factors and the overall performance of the shingle are fully persuasive of its non-obviousness. No findings are made as to claims other than those listed.

A ruling as to validity may be essentially moot, in view of the judgment of unenforceability, but if the Court of Appeals should reverse as to the latter, trial as to validity was completed, and there should not have to be a possible second appeal in order to review validity. The court will enter judgment as to both.

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[1] Indeed, defendants originally contended the judgment should read as now proposed in paragraph 3. See Defendants' Reply to Plaintiff's Brief After Trial, p. 57.

Appendix J

NOTE: This Order has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.

United States Court of Appeals

for the Federal Circuit

87-1142, 87-1172

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF-APPELLANT,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS-CROSS-APPELLANTS.

ORDER

A suggestion for rehearing in banc having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the suggestion for rehearing in banc is declined.

FOR THE COURT:
/sig/
Francis X. Gindhart, Clerk

2/18/88
Date
cc: Mr. G. Roger Lee
Mr. David Wolf

Appendix K

NOTE: This Order has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.

United States Court of Appeals

for the Federal Circuit

87-1142, 87-1172

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF-APPELLANT,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS-CROSS-APPELLANTS.

Before RICH, SMITH, and NIES, *Circuit Judges*.

ORDER

A petition for rehearing having been filed in this case by appellants,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, denied.

The suggestion for rehearing in banc is under consideration.

FOR THE COURT:
/sig/
Francis X. Gindhart, Clerk

2/2/88
Date

cc: Mr. G. Roger Lee
Mr. David Wolf

Appendix L

NOTE: This Order has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.

United States Court of Appeals

for the Federal Circuit

87-1142, 87-1172

BRUCE'S SPLICING & RIGGING CO., INC.,
PLAINTIFF-APPELLANT,

v.

THOMAS FERREIRA, ANDREW BRENNAN, AND
F & B ENTERPRISES, INC.,
DEFENDANTS-CROSS-APPELLANTS.

Before RICH, SMITH, and NIES, *Circuit Judges*.

ORDER

A petition for rehearing having been filed in this case by appellees,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, denied.

FOR THE COURT:
/sig/
Francis X. Gindhart, Clerk

2/2/88
Date
cc: Mr. David Wolf
Mr. G. Roger Lee